

## REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 20-23, 38-50.

The following claims are *independent*: 20, 21, 38 and 39.

The following claims have previously been *cancelled* without prejudice or disclaimer: 1-19, 24-37.

Please *add* new claims 46-50 and please *amend* claims 20, 21, 38 and 39; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

### **Claim Rejections - 35 U.S.C. § 103**

The Office Action rejected claims 20-23 and 38-45 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Himmelstein, US Application No. 2002/0038278 (hereinafter “Himmelstein”), in view of Russo, US Application No. 2004/068458 (hereinafter “Russo”). Applicant respectfully traverses these rejections and submits that

a *prima facie* showing of obviousness has not been established and that the applied references, taken individually or in combination, fail to discuss or render obvious every element of each pending claim.

### **Requirements to Establish Prima Facie Obviousness**

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as "Graham factors," which include that "[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved." *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*<sup>1</sup>, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

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<sup>1</sup> The "[Graham] factors continue to define the inquiry." 550 U.S. 398 (2007).

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(A)** and/or **(B)**, and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

### Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following element(s) as recited, *inter alia*, in currently amended independent claim(s) 20:

A processor implemented method comprising:

...  
determining via the processor, based at least in part on the second order destination alternative selected by the user, a list of at least one order type alternative consisting of only order type alternatives that are supported by the second order destination, the at least one order type alternative being different from the first order type alternatives listed in the first order type menu and displayed as part of a second order type menu that includes only the order type alternatives from the determined list of second order type alternatives that are supported by the second order destination;  
...

The Office Action concedes that:

Himmelstein did not explicitly disclose the step of receiving via the processor a user defined selection of a second order destination alternative from said order destination menu, the second order destination alternative representing a second order destination; determining via the processor, based at least in part on the second order destination alternative selected by the user, at least one order type alternative associated with the second order destination, the at least one order type alternative being different from the order type alternatives listed in the first order type menu and to be displayed as part of a second order type menu. (Office Action, pg. 4, § 4).

The Office Action goes on to allege that the previously pending claim elements are shown in Russo para. 0229-0242 (Office Action, pg. 4 § 4). Applicant respectfully disagrees and submits that the Office Action's characterization of Russo is unreasonably broad.

Contrary to the Office Action's assertions, Applicant submits that Russo is directed to *a device that requests separate user inputs without regard for previous user inputs, therefore allowing for inconsistent entries* instead of the claimed "populating ... based at least in part on the second order destination alternative selected by the user, a list of at least one order type alternative" (claim 20). For example, Applicant notes that Russo accepts user input of a first field, as "the 'user' of the machine has decided to program a NYSE and or a New York Stock Exchange listed stock symbol" (Russo, pg. 19, para. 0227). Next, the user must enter the desired stock symbol, as the device displays "(NYSE) WHAT SYMBOL" (Russo, fig. 53) and the specification explains, "By utilizing the Keyboard keys the 'user' of the machine types in the desired NYSE listed stock symbol." (Russo, pg. 19, para. 0227). Since the user enters the information him or herself, the possibility exists for an incorrect entry, which causes the device to display a "NO SUCH SYMBOL EXIST, reply, meaning try another symbol" (Russo, pg. 20, para. 0228). Accordingly, Applicant submits that Russo's device which allows for inconsistent and conflicting entries is different from at least the cited

elements of independent claim 20. Accordingly, Applicant respectfully requests reconsideration and withdrawal of rejections.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference; more specifically, Applicant respectfully requests additional clarification as to how and specifically why the Examiner believes the cited portion of Russo is allegedly analogous to and/or renders obvious the cited element of claim 20.

Although of different scope than independent claim(s) 20, Applicant submits independent claims 21, 38 and 39 are also not discussed or rendered obvious by the cited references, taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the Office Action's application of Himmelstein and Russo with regard to independent claim 20. Furthermore, Applicant submits claims 22, 23 and 40-45, which depend directly or indirectly from independent claims 20, 21, 38 and 39, are also not discussed or rendered obvious by the cited references, taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

## **CONCLUSION**

Applicant asserts that the above remarks, which distinguish the claims over the cited

reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting

remarks and claimed inventions, claims 20-23, 38-50, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

### **Authorization**

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-452. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-452.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,  
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